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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/820,455 | 04/08/2004 | Myles S. Douglas | ENDOLOG.054A | 7278 |
| 20995 7590 10/27/2010 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614 | | | | |
| EXAMINER TYSON, MELANIE RUANO | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 3773 | | | | |
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| 10/27/2010 | | ELECTRONIC | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/820,455

Applicant(s)

DOUGLAS ET AL.

Examiner

MELANIE TYSON

Art Unit

3773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 31-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 31-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This action is in response to the applicant's amendment received 16 August 2010. The application is not in condition for allowance for the reasons set forth below. Claims 19-30 remain cancelled.

Response to Arguments

Applicant's arguments filed 16 August 2010 with respect to the Smith reference have been fully considered and are persuasive (see interview summary dated 13 August 2010 for further details). Therefore, the previous rejection has been withdrawn and a new rejection is set forth below.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-18 and 31-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Solovay (U.S. Patent No. 5,843,161), Smith et al. (U.S. Patent No. 5,824,046), and Shaolian et al. (U.S. Patent No. 6,197,049).

Solovay discloses a stent graft (see entire document) comprising a tubular support (frame structure 12) and a porous tubular sheath (14) on the tubular support (12). Solovay further discloses that the sheath is configured to inhibit sufficient cellular ingrowth on the luminal surface through its wall (for example, see column 2, lines 63-67). Solovay fails to disclose the tubular porous sheath is formed specifically of ePTFE material.

Smith discloses a sheath (12) for a stent graft device (see entire document). Smith teaches forming the sheath of ePTFE material, since such material provides the advantages of good stretching and expanding characteristics, while also exhibiting sufficient radial strength for its intended purpose (for example, see column 5, lines 20-50). It would have been obvious to one having ordinary skill in the art at the time the invention was made to form Solovay's sheath from ePTFE material as taught by Smith, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice. Solovay as modified by Smith fails to disclose the tubular support is structured as recited in the claims.

Shaolian discloses a stent graft and teaches the stent is formed as a tubular wire support having all the configurations as claimed (see columns 6-21). The substitution of one known element (stent as shown in Shaolian) for another (stent as shown in

Solovay) would have been obvious to one of ordinary skill in the art at the time of the invention since the substitution of the stents would have yielded predictable results, namely, providing an expandable body that sufficiently supports a blood vessel.

With further respect to claims 2-10, 17, and 31-43, Smith incorporates by reference U.S. Patent No. 5,175,052 to Tokuda for manufacturing the porous ePTFE tape that forms the sheath, in which Tokuda discloses the porosity, pore size, permeability, and thickness of the sheath are easily formed and controlled as desired by a stretch ratio adjustment. It is well known in the art that different applications and the intended use of the stent graft dictates the characteristics required to effectively treat the diseased tissue. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the sheath having a density, a thickness, a distance between nodes, and a water pressure entry within the ranges claimed if the application required such characteristics, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELANIE TYSON whose telephone number is (571) 272-9062 and e-mail address is Melanie.tyson@uspto.gov. The examiner can normally be reached on Monday through Thursday 8-7 (max flex)

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Melanie Tyson/
Examiner, Art Unit 3773
October 22, 2010